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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/518,041

Filing Date: March 02, 2000

Appellant(s): JERDING ET AL.

Karen G. Hazzah
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 8, 2008 appealing from the Office action mailed July 7, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

1. Claims **137-144** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. Claims **137-144** are directed towards a computer-readable medium; however, Appellant's specification states that the term "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, solid-state, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation

medium (p. 15, lines 19-24 & p. 16, line 1). Appellant's specification further states that the computer-readable medium may include an electrical connection having one or more wires (p. 15, lines 2-4), an optical fiber (p. 15, line 8), or even paper upon which the program is printed (p. 15, lines 9-13). The examiner notes that a claim directed to a signal or law of nature *per se* does not appear to be a process, machine, manufacture, or composition of matter. The examiner further notes that a claim directed to paper with a program printed on it does not appear to be a process, machine, manufacture, or composition of matter. See **MPEP 2106.01** for guidance.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,850,218	LaJoie et al.	12-1998
5,812,123	Rowe et al.	9-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

New Grounds of Rejection

1. Claims **137-144** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. Claims **137-144** are directed towards a computer-readable medium; however, Appellant's specification states that the term "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device.

The computer readable medium can be, for example but not limited to, an electronic, solid-state, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium (p. 15, lines 19-24 & p. 16, line 1). Appellant's specification further states that the computer-readable medium may include an electrical connection having one or more wires (p. 15, lines 2-4), an optical fiber (p. 15, line 8), or even paper upon which the program is printed (p. 15, lines 9-13). The examiner notes that a claim directed to a signal or law of nature *per se* does not appear to be a process, machine, manufacture, or composition of matter. The examiner further notes that a claim directed to paper with a program printed on it does not appear to be a process, machine, manufacture, or composition of matter. See **MPEP 2106.01** for guidance.

Existing Grounds of Rejection

1. Claims **121-144** are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al. in view of Rowe et al.

Referring to claims **121**, **129**, and **137**, LaJoie et al. discloses a set-top terminal (STT)/method/computer-readable medium comprising:

- memory configured to store an interactive program guide (IPG)(col. 13, l. 39-56), the IPG configured to display, on a display screen, program information related to a plurality of television programs, the program information for each television program including at least a title of the television program, a start time of the television program, and a channel on which the television program can be viewed (col. 23, l. 44-67; col. 24, l. 1-51 & Fig. 16); and

- a processor in communication with the memory, the processor configured to control the IPG to display the program information (col. 13, l. 22-35);
- wherein the processor is further configured to receive an arrangement instruction from a viewer to display the program information in one of at least two views including at least a first view and a second view (Time, Theme, and Title of the Browse by menu)(col. 26, l. 27-47 & Figs. 16, 19),
 - o wherein the first view (Time mode) includes television program titles arranged in columns corresponding to sequential broadcast times and in rows corresponding to sequential channels (col. 23, l. 44-67; col. 24, l. 1-51; & Fig. 16), and
 - o wherein the second view (Theme or Title modes) includes television program titles arranged in rows corresponding to sequential broadcast times (col. 26, l. 48-67; col. 27, l. 67; col. 28, l. 40; & Figs. 20, 22); and
- wherein the processor is further configured to, responsive to receiving an activation instruction from a viewer, change the display screen from a program view predominantly showing a television program to an IPG view predominantly showing program information (col. 25, l. 61-67 & Figs. 16, 18); and
- wherein the processor is further configured, responsive to receiving a focus instruction subsequent to the activation instruction, to center the sequential channels on the channel corresponding to a current program to which the STT is tuned, and to highlight the one of the television program channels corresponding to the current program (the examiner notes that, in selecting to switch between Time, Theme, and

Title modes, the channel, program, theme, title, and time that is highlighted as default corresponds to the program being viewed in the program viewing window)(col. 23, l. 44-61; col. 24, l. 52-67; col. 25, l. 1-14; col. 26, l. 27-67; col. 27, l. 1-7, 64-67; col. 28, l. 1-15; & Figs. 16, 19, 20, 22).

LaJoie et al. does not disclose, in response to an activation instruction from the viewer, changing the display screen from a program view predominantly showing a television program to an IPG view predominantly showing program information in a view corresponding to the received arrangement instruction. Rowe et al. discloses allowing a user to browse through programming information using browsing category and subcategory tiles (col. 9, l. 45-65). Rowe et al. further discloses saving the settings for the category and subcategory displays, such that the viewing session arrangement is saved for use the next time the user activates the program schedule system (col. 17, l. 60-67; col. 18, l. 13; & Fig. 10). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the mode settings of LaJoie et al., such that they are saved when the user exists the program guide session, such as that taught by Rowe et al. in order to provide a highly intuitive user interface for a programming guide system to support a simple and convenient selection of desired programming information (Rowe et al. col. 4, l. 48-51).

Referring to claims **122, 130, and 138**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 121, 129, and 137, respectively, wherein the memory receives the program information from a server (LaJoie et al. col. 14, l. 13-18; col. 16, l. 10-67; & col. 17, l. 1-15).

Referring to claims **123**, **131**, and **139**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 121, 129, and 137, respectively, wherein the first view further includes a column of channel names and channel numbers (LaJoie et al. col. 24, l. 9-13 & Fig. 16).

Referring to claims **124**, **132**, and **140**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 121, 129, and 137, respectively, wherein the processor is further configured to provide an option to a viewer on the IPG view to provide the arrangement instruction (LaJoie et al. col. 26, l. 27-47 & Figs. 16, 17, 19-23).

Referring to claims **125**, **133**, and **141**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 121, 129, and 137, respectively, wherein the processor is further configured to enable the viewer to select an option to display the last IPG view that was in effect at the time of exit from an IPG view when the display screen has been changed from the IPG view back to the program view predominantly showing a television program (the examiner notes that the combination of LaJoie et al. and Rowe et al. teaches saving the mode of the last program guide session. By re-activating the guide, the previously settings will be restored)(LaJoie et al. col. 25, l. 61-66 & Fig. 18).

Referring to claims **126**, **134**, and **142**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 121, 129, and 137, respectively, wherein, in response to receiving the arrangement instruction, the processor is further configured to display the program information in one of at least three views including at least a time view, a theme view, and a title view (LaJoie et al. col. 26, l. 27-47 & Figs. 16, 19, 20, 22).

Referring to claims **127, 135, and 143**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 126, 134, and 142, respectively, wherein the processor is further configured to enable the viewer to select an option to initially display a menu within the at least three views, the menu enabling the user to select the time view, theme view, or title view (LaJoie et al. col. 26, l. 27-47 & Figs. 16, 29, 20, 22).

Referring to claims **128, 136, and 144**, the combination of LaJoie et al. and Rowe et al. teaches the STT/method/computer-readable medium of claims 127, 135, and 143, respectively, wherein the processor is further configured to enable the viewer to select an option to disable the display of the menu (LaJoie et al. col. 26, l. 23-26).

(10) Response to Argument

Argument A: Rejection of Claims 121-144 under 35 U.S.C. 103: *LaJoie et al.* and *Rowe et al.*

Regarding claims **121-144**, the appellant argues that the combination of LaJoie et al. and Rowe et al. does not disclose, teach, or suggest all elements/features/steps of the claims at issue. The examiner respectfully disagrees for the reasons described below.

Arguments A1, A2, & A3: Independent Claims 121, 129, and 137

Regarding independent claims 121, 129, and 137, the appellant argues that the combination of LaJoie et al. and Rowe et al. fails to teach, disclose or suggest at least “wherein the processor is further configured, *responsive to receiving a focus instruction* subsequent to the

activation instruction, to center the sequential channels on the channel corresponding to a current program to which the STT is tuned, and to highlight the one of the television program channels corresponding to the current program" (italicized to reflect Appellant's emphasis). The examiner respectfully disagrees. LaJoie et al. discloses an interactive program guide (IPG) with time, theme, and title modes (Fig. 16). From any television display 396, pressing guide key 398 causes set-top terminal 6 to enter the time mode of the interactive program guide 400 (col. 25, l. 61-66 & Fig. 18). As such, the examiner interprets pressing guide key 398 to be an "activation instruction," as currently claimed. From a time mode display 414 of the guide, pressing "B" application definable key 252 causes a theme mode display 416 of the guide to be presented. Pressing "C" application definable key 252 from time mode display 414 causes title mode display 418 of the guide to be displayed. From either the theme mode or title mode, pressing "A" application definable key 252 causes the display to switch to time mode display 414 (col. 26, l. 27-47 & Fig. 19). Within the guide, the user navigates the program listings of grid 366 to highlight the desired program cell 396 within cursor 394 by pressing up, down, left, and right arrow keys. Cursor 394 is always shadowed in channel list 350 by channel shadow 392 and in date and time bar 348 by time shadow 393. Channel shadow always remains vertically aligned with cursor 394 to indicate the channel on which the program highlighted by cursor 394 can be found. Time shadow 393 always remains horizontally aligned with cursor 394 to show the beginning of the time frame highlighted by cursor 394. For example, as shown in "KCBS 2" in channel list 350 and "4:00 pm" in date and time bar 348 are shadowed by channel shadow 392 and time shadow 393, respectively, to indicate that "CBS Sports..." is on channel "KCBS 2" at "4:00 pm." Cursor 394 does not move within grid 366 of the IPG. Program cells 396 of grid

366, call signs 388 and channel numbers 390 of channel list 350, and times 386 of date and time bar 348 scroll instead (col. 24, l. 34-56). Since the cursor does not move, the examiner notes that the cursor and channel shadow remain centered. LaJoie et al. further discloses that, when the user switches modes in the IPG, the default program highlighted and centered upon entering the new mode corresponds to the program being viewed in program viewing window 340 (col. 26, l. 64-67; col. 27, l. 1-7; col. 28, l. 5-15; & Figs. 16, 19, 20, 22). As such, the examiner interprets the switching of modes to be “a focus instruction, subsequent to the activation instruction, to center the sequential channels to a current program to which the STT is tuned, and to highlight the one of the television program channels corresponding to the current program,” as currently claimed.

Appellant assumes that the examiner’s characterization of LaJoie et al. is accurate, and that switching IPG modes results in the program presented in program viewing window 340 being highlighted and centered in the IPG. Appellant argues that the highlighting and centering behavior in LaJoie et al. does not occur in response to a “focus instruction,” but instead to a user request to change IPG modes. The examiner respectfully disagrees. The examiner maintains that a user request to change IPG modes is a “focus instruction,” as currently claimed, since it results in the program presented in the program viewing window 340 being highlighted and centered in the IPG, as recited in Appellant’s claims. Appellant further argues that the position taken by the examiner, that an IPG mode switch is the same as a focus instruction, confuses a request for a specific action (switch modes) with a side effect of that action (highlighting and centering). The examiner notes; however, that there is no structural or manipulative difference between the function being performed by LaJoie et al. and that recited in the claims. The

examiner further notes that a recitation of the intended use of the claimed invention must result in a structural or manipulative difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Argument A4: Dependent Claims 122-128, 130-136, and 138-144

Appellant submits that dependent claims 122-128, 130-136, and 138-144 are allowable for at least the reason that each depends for man allowable claim. The examiner respectfully disagrees for the reasons stated above with respect to the independent claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of

Art Unit: 2424

rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Michael Van Handel

/Michael Van Handel/

Examiner, Art Unit 2424

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Timothy Callahan

/Timothy P. Callahan/

Director, Technology Center 2400

Conferees:

Chris Kelley

/Chris Kelley/

Supervisory Patent Examiner, Art Unit 2424

Chris Grant

/Christopher Grant/

Supervisory Patent Examiner, Art Unit 2400